

**AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawings includes a change to Figure 2. On Figure 2, reference number 42 directed to the notch on the base 12 is changed to 58.

### **REMARKS**

Receipt of the final office action mailed May 23, 2008, is acknowledged. Claims 1, 3, 5-12, and 14-22 are pending in the application. Claims 1, 12, 20, and 21 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 3, 5-12, and 14-22 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2002/0111203 (Chi).

Applicant resubmits herewith the replacement drawing sheet amending to Figure 2 to identify the notch on base 12 by reference number 58 rather than 42. In the Amendment in Response to Non-Final Office Action dated February 6, 2008, both the specification and the drawing were amended to identify the notch on base 12 by reference number 58. The specification previously identified both the notch and a fold-line of the substrate assembly with reference number 44, while the drawing incorrectly used reference number 42 to identify the notch. Accordingly, both the specification and the drawings were amended to identify the notch by reference number 58, a reference number that had not been assigned to any other element. Consequently, the examiner has improperly refused to enter the replacement figure filed on February 6, 2008.

#### **A specification that shows and describes the claimed invention enables the claims, and thus the enablement rejection must be withdrawn**

First, in order to move this application forward, Applicant has made a clarifying amendment to claims 1 and 12, which renders the enablement rejection of those claims moot. Claims 1 and 12 now both recite, in part, that puzzle piece directly contacts an upper one of the first or second substrates. The specification states “the assembled image 24 is constructed of a plurality of individual puzzle pieces 26-1 through 26-15” (see specification at page 4), and states “the assembled image may be placed directly on a surface 38 of the substrate assembly 36.” (specification at page 5-6). The Figures show what is described in the specification, with the lower surface of a puzzle piece disposed in direct contact on an upper one of the substrates. Accordingly, the claims are fully enabled, no new matter is added, and claims 1 and 12 are in proper form.

With respect to claims 20 and 21, the rejection is completely devoid of merit. Figures 3-7 of the specification clearly show a substrate assembly having three (3) layers or

substrates. If applicant were to attempt to claim “at least four substrates” then the claim would not be supported. But, applicant has shown three substrates, described three substrates, and claimed “only” the three substrates in claims 20 and 21. Yet, the rejection is based on the premise that a specification that shows and describes three substrates does not enable one of skill in the art to construct the claimed device with three substrates and no more. This is absurd on its face. The claims are fully supported and enabled, and therefore the rejection is devoid of merit and must be withdrawn.

Similarly absurd is the enablement rejection of claim 21, which recites that “the second substrate [has] only a plurality of conductive ink dots.” If applicant were to attempt to claim the second substrate had plurality of conductive ink dots and, for example, the key structure of Chi, such a claim would not be supported. If Applicant were to claim the second substrate that is devoid of anything, then that substrate could not cooperate with the first substrate to form a circuit, and such a claim would not be supported or enabled by the specification. Once again, the rejection is based on the premise that a specification that shows and describes a second substrate having only a plurality of conductive dots and nothing more does not enable one of skill in the art to construct the claimed device with a second substrate having only conductive dots, with no more and no less. Once again, the logic of such a rejection is absurd. The claim is fully supported and enabled, and therefore the rejection is devoid of merit and must be withdrawn.

**If the Office can provide a justification to ignore a claim limitation merely because the specification calls that limitation a “preferable” option, then the Office is invited to provide such a justification in a new and non-final action**

It is clear from page 4 of the detailed action, at lines 10-12, that the office action ignores the limitation in claim 1 that the substrate assembly is formed from the “same piece of a single paperboard blank.” Claim 12 recites a similar limitation, stating the “substrates [are] formed from connected portions of the same paperboard panel.” As pointed out by the action, the specification contemplates a number of options, such as forming the substrate assembly from a single piece of paperboard material, or forming the substrate assembly from separate pieces of paperboard material. It is beyond dispute that claims 1 and 12 claim the first option, and there is no reasonable basis to ignore this limitation, which is expressly recited in claims 1 and 12.

Section 2134.03 of the MPEP expressly states that “All words in a claim must be considered in judging the patentability of that claim against the prior art.” The action fails to satisfy this standard. In order to move this application forward, the Applicant hereby requests the Office to provide support for the notion that the Office is free to completely ignore an express claim limitation.

**The action repeatedly skips the required step of establishing a proper *prima facie* case of obviousness, and instead “supports” the flawed obviousness rejections on the basis that Applicant has not disclosed rebuttal evidence**

Section 2142 of the MPEP outlines the obviousness inquiry with great clarity:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.

\*\*\*

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to render obvious the claimed invention (citations omitted).

The same section of the MPEP also outlines the “key steps” in establishing a proper *prima facie* case of obviousness as follows:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In *re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Here, the action repeatedly does exactly what the Federal Circuit and the MPEP prohibit. For example, the action expressly admits Chi fails to disclose paperboard substrates made of the same piece of paperboard material. However, instead of *articulating a*

*suggestion* to discard the conductive film of Chi in favor of a paperboard substrate assembly formed of a single paperboard blank, the action merely *concludes* that the change is obvious.

There is no requirement in 35 U.S.C. § 103(a) that the applicant demonstrates that a claim limitation solves any stated problem, provides an advantage, or is for any particular purpose. Rather, to establish a *prima facie* case of obviousness, the examiner must show that the claimed invention as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art. 35 U.S.C. § 103(a); and MPEP § 2142; *see also In re Royka*, 490 F.2d 981 (C.C.P.A. 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Section 2143.01 states that “Obviousness can be established by . . . modifying the teachings of the prior art to produce the claimed invention *where there is some teaching, suggestion, or motivation to do so.*” (citing *In re Kahn*, 441, F.3d 997, 986 (Fed. Cir. 2006)) (emphasis added).

With the foregoing in mind, we turn to the claims at issue.

**A device that *must have* an intervening structure that *precludes* direct contact cannot anticipate or render obvious a claim that *must not have* an intervening structure and that *requires* direct contact**

Claims 1 and 12 positively recite, in part, that “a lower surface of the puzzle piece directly contacts an upper one of the first or second substrates” to activate the sound generator. That is, regardless of which of the first or second substrate is the upper substrate, that upper substrate must be contacted directly by the lower surface of the puzzle piece.

By comparison, and as pointed out in the prior response, the device of Chi uses an intervening face panel 34 that precludes direct contact between the puzzle piece and the upper circuit-contained film 31. Specifically, when a puzzle piece is placed on the face panel 34, the downward force of the puzzle piece 41 causes keys 341 on the lower surface of the face panel to move downward, which causes electric contact of two corresponding contacts 311, 331. Chi, paragraph 28-29. Accordingly, Chi does not disclose or suggest direct contact between the puzzle piece and the first or second substrate as disclosed in each of claims 1 and 12.

**A device that expressly touts improving the intervening key structure between the puzzle and the circuit cannot be modified to eliminate that key structure entirely**

**without destroying the express teachings of the reference and without changing the principle of operation of the reference**

With further respect to claims 1 and 12, there can be no dispute that the needed modification to Chi requires the elimination of the key structure. Where, exactly, is a viable suggestion to modify Chi by discarding the keys 341 and the face panel 34, when the very act of discarding the key/face panel structure flies in the face of Chi's stated goal of providing "a sound-emitting jigsaw puzzle having *improved key structure*." Chi, paragraph 1. The fact of the matter is there can be no proper suggestion to discard the key/face panel arrangement to reach the direct contact claimed by claims 1 and 12. Accordingly, the action wholly fails to establish a proper *prima facie* case of obviousness, and claims 1 and 12 are in allowable form.

**A device that expressly teaches four individual films or layers, not all of which are made of the same material, cannot be modified to require no more than three layers made from the same material**

Claim 20 recites only a first, only a second, and only a third substrate, with no additional substrates or layers. Claim 20 further recites that the three layers substrates are formed of the same paperboard panel connected by fold lines.

By comparison, the reference uses four layers, consisting of the upper and lower circuit-contained films 31 and 33, the isolating film 32, and the rubber face panel 34. As is apparent from Figure 1, none of these layers or films are connected to one another by fold lines. Instead, the reference expressly teaches joining the layers using a series of "screws 344 screwed in through a press plate 343 and the fastening holes 342, 312, 332 and 241" to bind the face panel 34, the upper and lower films 31 and 33, and the isolating film 32 together as one key unit 3. See paragraph 23 of the reference.

Further, it is readily apparent from a quick review of Figures 5 and 6 of the reference that the face panel 34 and the films 31, 32 and 33 cannot possibly be formed of the same piece of material, much less formed of a paperboard material. Instead, the face panel 34 is notably dissimilar than the remaining films, in fact the reference expressly teaches that the face panel 34 "is made of a high durometer foam rubber material." See paragraph 23.

In sum, the reference expressly teaches making one of the layers of the dissimilar material, which precludes making all of the layers of the same material. The dissimilar materials also precludes having a layers connected by fold lines.

Consequently, claim 20 is in allowable form.

**A device that expressly teaches two “circuit-contained films” cannot be modified to eliminate the circuit from one of the films**

Claim 21 positively recites that the first substrate has a plurality of conductive ink patterns, and the second substrate has only a plurality of conductive ink dots.

By comparison, in the reference both of the films 31 and 33 are described as "circuit-contained" films. Viewing Figure 1, it is readily apparent that both of these films include circuits. Paragraph 22 of the reference describes how these films cooperate with one another when fully overlapped. If one were to modify one of these "circuit-contained films" by eliminating the circuit from one of the films, then the device would cease to function. A dot is not a circuit and cannot function as the circuit. In order to function, the reference requires a circuit on both films 31 and 33. Yet, eliminating the circuit from one of the films and replacing that circuit with a series of conductive ink dots would render the device inoperable. Consequently, there can be no suggestion to make the needed modification, and claim 21 is in allowable form.

All dependent claims depend from allowable independent claims. Accordingly, all remaining dependent claims are in allowable form.

In view of the above arguments, applicant believes the pending application is in condition for allowance.

Dated: September 11, 2008

Respectfully submitted,

By   
David C. Read

Registration No.: 39,811  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorney for Applicant